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7 The Honorable S. Kate Vaughan
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UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
AT SEATTLE

TSR LLC,

Plaintiff,

v.

WIZARDS OF THE COAST LLC,

Defendant.

WIZARDS OF THE COAST LLC,

Counterclaim Plaintiff,

v.

TSR LLC; JUSTIN LANASA; and DUNGEON
HOBBY SHOP MUSEUM LLC,

Counterclaim Defendants.

No. 2:21-cv-01705-SKV

**REPLY IN SUPPORT OF
MOTION FOR PRELIMINARY
INJUNCTION**

**Noted for consideration:
October 28, 2022**

**ORAL ARGUMENT
REQUESTED**

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1 Counterclaim Defendants dispute few of the central points that support Wizards' Motion
 2 for a preliminary injunction prohibiting Counterclaim Defendants from selling, promoting, or
 3 distributing Star Frontiers New Genesis (SFNG). They *admit* Wizards has used the Star Frontiers
 4 and TSR Marks in commerce since before Counterclaim Defendants used the Marks or registered
 5 them with the USPTO, which establishes that Wizards' rights in the Marks are superior, even
 6 though its registrations lapsed. They *admit* Wizards has evidence of consumer confusion, even
 7 though they quibble with its significance—which shows a likelihood of confusion, even though
 8 such a showing is not required for preliminary relief. And they *concede* Counterclaim Defendants
 9 have no equitable interest in publishing or distributing SFNG, a game they claim does not yet exist.

10 Counterclaim Defendants' main argument is that the version of SFNG upon which Wizards
 11 relies—which this Reply calls the “Subpoenaed SFNG”—is not the real thing. At most, this point
 12 goes to whether Wizards is likely to be irreparably harmed by the activity it moves to enjoin. But
 13 Counterclaim Defendants' argument misses the mark. Even if they are correct about the
 14 provenance of the Subpoenaed SFNG—and that is doubtful, based on metadata associated with
 15 the document—they do not and cannot dispute that the document was distributed publicly *only*
 16 *because* Counterclaim Defendants were developing SFNG. And, in any event, the document the
 17 Counterclaim Defendants submit as the actual SFNG draft—the “LaNasa SFNG”—still contains
 18 offensive content. Publication or further distribution of any version of SFNG thus will irreparably
 19 harm Wizards' reputation as a leading publisher of high-quality, inclusive RPGs.

20 The Court should grant Wizards' motion and enjoin Counterclaim Defendants'
 21 infringement of Wizards' Star Frontiers and TSR Marks in the SFNG game.

22 **A. Wizards Has Shown It Is Likely to Succeed on the Merits.**

23 All parties agree on the key facts regarding their respective uses of the Marks. Wizards
 24 acquired TSR, Inc. and its intellectual property, including the Star Frontiers and TSR Marks, in
 25 1997. *See* Wizards' Mot. Prelim. Inj. (corrected), Dkt. No. 35-2 (Mot.) 1; Dkt. No. 37 (Resp.) 1.
 26 While Wizards did not maintain USPTO registrations, *see* Mot. 3; Resp. 2, it has continuously
 27 used the Marks in commerce since January 2013 for the TSR Mark and November 2017 for the

1 Star Frontiers Mark. Mot. 2; Resp. 4. This use predates TSR LLC’s USPTO registration of the
 2 Marks, which began no earlier than 2020 and 2021. Mot. 2-3; Resp. 3.¹

3 Counterclaim Defendants argue that Wizards has not shown a likelihood of success on the
 4 merits, despite these undisputed facts, but each of their arguments fall short.

5 **1. Wizards Will Succeed on Its Claim for False Designation of Origin.**

6 Wizards has established that it is likely to succeed on its claim that Counterclaim
 7 Defendants “(1) use in commerce (2) any word, false designation of origin, false or misleading
 8 description, or representation of fact”—the Marks—“which (3) is likely to cause confusion or
 9 misrepresents the characteristics of [their] goods or services.” *Freecycle Network, Inc. v. Oey*, 505
 10 F.3d 898, 902-04 (9th Cir. 2007) (citing 15 U.S.C. § 1125(a)). Counterclaim Defendants fail to
 11 show otherwise.

12 **a. Counterclaim Defendants Use Wizards’ Marks in Commerce.**

13 Counterclaim Defendants argue that the SFNG listing on the Museum and TSR LLC
 14 websites displayed “merely a digital mockup” and “not an actual product that could even
 15 potentially be offered for sale at this point,” Resp. 18, but they do not and cannot dispute that sales,
 16 marketing, and distribution of SFNG—the activities Wizards asks this Court to enjoin—would
 17 constitute use in commerce. Counterclaim Defendants have themselves represented that they
 18 intend to use the Marks in commerce, averring in each of the applications filed with the USPTO
 19 that “[t]he applicant has a bona fide intention... to use the mark in commerce on or in connection
 20 with the identified goods/services.” Decl. of Justin LaNasa, Dkt. No. 39 (LaNasa Decl.), Ex. A at
 21 4, 8; Ex. B at 4, 8; Ex. C at 4, 7; Ex. F at 4, 8; Ex. G. at 4, 7-9. The LaNasa Declaration supporting
 22 Counterclaim Defendants’ Response to Wizards’ Motion likewise states that TSR LLC “has been
 23 using the TSR letters”—i.e., the TSR Mark—“in commerce since March and April 2021” and
 24 “continues to do so through today.” LaNasa Decl. ¶ 11.

25 Wizards need not wait until Counterclaim Defendants’ infringing SFNG publication is
 26

27 ¹ Counterclaim Defendants correct an error in the registration number for TSR Inc.’s 1992 application for the TSR
 Mark, *see* Resp. 1 n.3, which is 1681176.

1 officially released before it can establish its likely success on the use-in-commerce element. To
2 the contrary, courts regularly enjoin future trademark use, including via preliminary injunctions.
3 See, e.g., *Canfield v. Health Commc’ns, Inc.*, 2008 WL 961318, at *3 (C.D. Cal. Apr. 1, 2008)
4 (preliminary injunction covering “use of the mark in relation to the mock-ups [for future
5 publications] that will be published in the coming year”); *Dr. Seuss Enters., L.P. v. Penguin Books*
6 *USA, Inc.*, 109 F.3d 1394, 1406 (9th Cir. 1997) (affirming “preliminary injunction prohibiting the
7 publication and distribution of the infringing work” that had been printed but not released for sale).
8 That Counterclaim Defendants have not yet “reaped any commercial benefit from... the SFNG
9 Game,” Resp. 18, makes no difference where they plan to do just that. Nor does that undermine
10 Counterclaim Defendants’ own representations to the USPTO and this Court that they will use and
11 currently are using the Marks in commerce.

b. Counterclaim Defendants' Use of the Marks Is Likely to Cause Confusion.

14 Wizards has established that Counterclaim Defendants' use of the Marks creates a
15 likelihood of confusion under the eight *Sleekcraft* factors, meeting this element of its
16 false-designation claim. *See* 15 U.S.C. § 1125(a)(1). Counterclaim Defendants say nothing about
17 Wizards' showing as to seven of those factors, which resoundingly demonstrate that Counterclaim
18 Defendants' use of the marks is likely to cause confusion. *See* Mot. 8-12.

19 Actual confusion—the main issue on confusion that Counterclaim Defendants address, *see*
20 Resp. 20-22—is only one factor in this test, and it is not dispositive. *AMF Inc. v. Sleekcraft Boats*,
21 599 F.2d 341, 353 (9th Cir. 1979), *abrogated on other grounds by Mattel Inc. v. Walking Mountain*
22 *Prods.*, 353 F.3d 792, 810 n.19 (9th Cir. 2003). “[D]ifficulties in gathering evidence of actual
23 confusion make its absence generally unnoteworthy,” *Perfumebay.com Inc. v. eBay Inc.*, 506 F.3d
24 1165, 1176 (9th Cir. 2007) (quoting *Au-Tomotive Gold, Inc. v. Volkswagen of Am., Inc.*, 457 F.3d
25 1062, 1077 (9th Cir. 2006)), and it is “of diminished importance” at the preliminary injunction
26 stage because “a motion for preliminary injunction normally occurs early in litigation,” before the
27 parties “have amassed significant evidence of actual confusion.” *Wells Fargo & Co. v. ABD Ins.*

1 & Fin. Servs., Inc., 758 F.3d 1069, 1072-73 (9th Cir. 2014); *see also Pom Wonderful LLC v.*
 2 *Hubbard*, 775 F.3d 1118, 1131 (9th Cir. 2014).

3 Even so, Wizards’ evidence of actual confusion is compelling. Counterclaim Defendants
 4 argue that the “cbwjm” post in the thread called “Does TSR3 Have Nazi Connections?” shows
 5 consumers are aware of the distinction between TSR LLC and TSR, Inc., but the post on its face
 6 attributes that clarity to “the 3 on the end of TSR.” Decl. of Lauren Rainwater, Dkt. 32 (Rainwater
 7 Decl.), ¶ 13. This proves Wizards’ point: without the “3”—which TSR LLC itself does not use
 8 on the SFNG cover or elsewhere—nothing apparently would distinguish TSR LLC from the
 9 original TSR, Inc. on whose reputation it trades. Wizards’ second example shows gamers’
 10 reasonable concern that people may “think that [the poster] buy[s] into” the offensive narrative.
 11 *Id.* And while Wizards’ third example shows commenters correcting an original poster with the
 12 accurate information that TSR LLC is not affiliated with Wizards, Resp. 21, this again proves the
 13 point: the original post shows confusion the other consumers must correct. *See* Rainwater Decl.
 14 ¶ 13. Wizards “need not prove that *every* customer was confused, only that there is a likelihood
 15 of confusion.” *Am. Rena Int’l Corp v. Sis-Joyce Int’l Co.*, 2012 WL 12538385, at *6 n.3 (C.D.
 16 Cal. Oct. 15, 2012) (granting preliminary injunction despite “several declarations of customers
 17 who claim that they were not confused,” which “do not disprove a ‘likelihood of confusion’ for
 18 [others]”), *aff’d*, 534 F. App’x 633 (9th Cir. 2013).

19 Counterclaim Defendants also argue that the “new and modern” “look and feel” of the
 20 SFNG mockup, as well as the passage of time “since the last edition [of Star Frontiers] was released
 21 by TSR, Inc.” somehow minimize the risk of confusion, Resp. 20, 22, but they offer no support in
 22 the *Sleekcraft* factors (or any other precedent) for why that is so. The issue is not that the products
 23 “look the same.” *Cf.* Resp. 22. The issue is that Counterclaim Defendants have created and are
 24 promoting an “all new” “return[],” *id.*, of Star Frontiers, using the Marks belonging to Wizards.
 25 No amount of new “artwork and coloring” or changes in “the tag line,” *id.*, can distinguish
 26 Counterclaim Defendants’ product from the original Star Frontiers brand, for which Wizards owns
 27 the trademark—*especially* since SFNG explicitly links to the original. *See* LaNasa Decl. Ex. K at

1 18 (“How is this game different from the previous iterations?”).

2 The remaining *Sleekcraft* factors—which Counterclaim Defendants do not address—
 3 further show Counterclaim Defendants’ use of the Marks is likely to confuse consumers:

4 **Strength of the Marks.** The Marks are arbitrary or fanciful, the “most distinctive”
 5 categories that “receive the most trademark protection.” *Pom Wonderful*, 775 F.3d at 1126.

6 **Proximity and Relatedness of Goods.** Counterclaim Defendants sell RPGs, exactly the
 7 same kind of products as those on which Wizards licenses its Marks.

8 **Type of Goods and Customer Care.** New players and other consumers encounter RPGs
 9 in various settings, and the low price point means purchasers “are likely to exercise less care, thus
 10 making confusion more likely.” *Brookfield Commc’ns, Inc. v. W. Coast Ent. Corp.*, 174 F.3d 1036,
 11 1060 (9th Cir. 1999).

12 **Similarity of the Marks.** The Marks at issue are identical.

13 **Marketing Channel Convergence.** Both Wizards and the Counterclaim Defendants
 14 market and advertise the products in similar channels. Counterclaim Defendants even advertised
 15 SFNG as a “return” of the original. *See* Resp. 22.

16 These factors all indicate the consumers are likely to be confused by Counterclaim
 17 Defendants’ use of the Marks—even without *any* showing of actual confusion. That Wizards has
 18 evidence that consumers actually were confused only further supports the conclusion that
 19 consumers are *likely* to be confused.

20 **2. Wizards Is Likely to Succeed on its Common Law Trademark Claim.**

21 Wizards will succeed on its claim for common law trademark infringement because it has
 22 shown it has a protectible interest in the Marks and that Counterclaim Defendants’ use is likely to
 23 cause consumer confusion, as discussed above. *See Bio Mgmt. Nw. Inc. v. Wash. Bio Servs.*, 2021
 24 WL 4319448, at *2 (W.D. Wash. 2021) (state trademark claim elements).

25 **a. Wizards Has a Protectible Interest in the Marks.**

26 Wizards’ continuous use of the TSR Mark since January 2013 and the Star Frontiers Mark
 27 since November 2017 establishes its superior rights in those Marks, compared to Counterclaim

1 Defendants' 2020 and 2021 registrations. Counterclaim Defendants argue that Wizards' Motion
 2 fails to establish its use of the Marks because it did not attach the licensing agreement with
 3 OneBookShelf. Resp. 4. However, Counterclaim Defendants ignore Elizabeth Schuh's
 4 uncontested declaration filed with Wizards' Motion, which states that Wizards has licensed the
 5 Marks to OneBookShelf, and that OneBookShelf has sold thousands of products bearing the TSR
 6 Mark for nine years and the Star Frontiers Mark for five. Dkt. No. 35-1, ¶¶ 6-8. Counterclaim
 7 Defendants offer no evidence refuting this sworn testimony, and, indeed, they cannot do so, as
 8 Wizards produced the licensing agreement to Counterclaim Defendants in discovery.²

9 This declaration establishes Wizards' licensing of the Marks, as well as its continuous use
 10 in commerce since 2013 and 2017 through sales of products bearing the Marks. It makes no
 11 difference that Wizards "does not account for any use of the Marks prior to those stated times,"
 12 Resp. 4: what matters is that Wizards has continuously used the Marks in commerce since *before*
 13 Counterclaim Defendants sought to use them. *See Airs Aromatics, LLC v. Victoria's Secret Stores*
 14 *Brand Mgmt., Inc.*, 744 F.3d 595, 599 (9th Cir. 2014) ("To establish a protectible ownership
 15 interest in a common law trademark, the owner must establish not only that he or she used the
 16 mark before the mark was registered, but also that such use has continued to the present." (Internal
 17 quotation marks omitted)). Counterclaim Defendants do not dispute that prior continuous use.
 18 And that is all that Wizards needs to establish its protectible ownership interest in the Marks.

19 **b. Wizards Has Shown Washington Use of the Marks.**

20 Counterclaim Defendants argue only that Wizards has not established a claim under
 21 Washington law because the statute deems a trademark "to be 'used' in this state when it is placed
 22 in the ordinary course of trade" on goods "sold or otherwise distributed" in Washington. Resp. 23
 23 (quoting RCW 19.77.010(11)). Wizards itself is located in Washington, and it licenses the Marks
 24 from there. Suppl. Decl. of Elizabeth Schuh, ¶ 2. Wizards' licensee OneBookShelf operates an
 25 online store with products bearing the Marks, making those products available for sale in

26
 27 ² Should the Court wish to see the licensing agreement, Wizards will supplement the record with the agreement upon
 request.

1 Washington. OneBookShelf's sales include actual sales in Washington. *See id.* ¶ 3.³

2 * * *

3 Wizards' strong showing on its likelihood of success on the merits supports a preliminary
 4 injunction, even without reference to the other *Winter* factors. *See BOKF, NA v. Estes*, 923 F.3d
 5 558, 562 (9th Cir. 2019) ("sliding scale test"). But the remaining *Winter* factors, too, favor a
 6 preliminary injunction preventing Counterclaim Defendants from further activity with SFNG.

7 **B. Regardless of Which Version of SFNG Is "Real," Counterclaim Defendants'
 8 Activity Irreparably Harms Wizards.**

9 Counterclaim Defendants spend the bulk of their brief on a sideshow: whether the version
 10 of SFNG on which Wizards' motion is based is authentic. Resp. 8-16.⁴ Despite its prominence in
 11 the Response, this issue is of minimal significance to the question before the Court. At most,
 12 Counterclaim Defendants' points here are relevant to whether an injunction will remedy the
 13 irreparable harm on which Wizards' Motion is based—i.e., whether enjoining Counterclaim
 14 Defendants' activities with respect to SFNG will prevent the distribution of the offensive material
 15 that would injure Wizards' reputation if consumers (mistakenly) associate it with Wizards.

16 To begin with, Counterclaim Defendants do not dispute that there is a presumption of
 17 irreparable harm, and they fail to rebut it. Even if that were not so, Wizards will be irreparably
 18 harmed absent an injunction restricting Counterclaim Defendants' activities, for three reasons:

19 *First*, available metadata evidence indicates the Subpoenaed SFNG originated with the
 20 Counterclaim Defendants. Wizards received the Subpoenaed SFNG from Wizard Tower Games
 21 (WTG), a company owned by Don Semora. *See Suppl. Decl. of L. Rainwater (Rainwater Suppl.*
 22 *Decl.)* ¶ 2. WTG produced the Subpoenaed SFNG as a PDF with corresponding metadata. *Id.* &

23 ³ Wizards offers this additional evidence, as well as other evidence discussed in this Reply, to corroborate what it
 24 submitted in its Motion and "in response to issues raised by the [Counterclaim Defendants'] memoranda," an
 25 appropriate use of new evidence on reply. *Kroeber v. GEICO Ins. Co.*, 2015 WL 11669649, at *2 (W.D. Wash. Mar.
 26 31, 2015); *see also, e.g.*, *King Cnty. v. Viracon, Inc.*, 2022 WL 838508, at *3 (W.D. Wash. Mar. 21, 2022).
 Counterclaim Defendants' preemptive request that the Court strike "any new material that Wizards may offer" or
 permit them an opportunity to respond, Resp. 8 n.8, has no basis where Wizards' reply evidence responds to issues
 they raised.

27 ⁴ Counterclaim Defendants also discuss a version of SFNG entitled "Star Frontiers Not Genuine." Resp. 6. Wizards
 has no knowledge of this document and does not rely upon it for its Motion.

1 Ex. A. The metadata shows two things. *First*, the author of the PDF is George Johnson—the
 2 admitted co-author of SFNG along with LaNasa. *See id.*; *see also* Decl. of Dave Johnson (Johnson
 3 Decl.), Dkt. No. 40, ¶ 3; LaNasa Decl. ¶ 3. *Second*, the PDF was created and last modified on
 4 February 12, 2022. Rainwater Suppl. Decl. Ex. A. This closely tracks the facts Counterclaim
 5 Defendants submit regarding sending SFNG to WTG for editing. *See* LaNasa Decl. ¶ 23, ¶ 41
 6 (attesting that “TSR provided Wizard Tower Games with the first draft of the SFNG Game in the
 7 form of an editable Google Doc document” “[o]n February 6, 2022” and that metadata on the
 8 version provided to WTG shows a February 6, 2022, date and “George Johnson” as the author).
 9 While the PDF metadata on the Subpoenaed SFNG is six days after the transmittal date to which
 10 LaNasa attests, other documents produced by WTG and Semora under subpoena show that
 11 Counterclaim Defendants continued working on the draft and sending updates to Semora around
 12 this time. Rainwater Suppl. Decl. ¶ 4 & Ex. C (Feb. 23, 2022, email from D. Johnson to WTG
 13 sharing SFNG document). This information, at the very least, undermines Counterclaim
 14 Defendants’ declaration testimony denying a connection with the Subpoenaed SFNG. And, while
 15 Johnson in particular attests that he “did not distribute the Google Doc document version of the
 16 SFNG Game to anyone except for Mr. LaNasa, at any time,” Johnson Decl. ¶ 6, the Subpoenaed
 17 SFNG and the emails produced by Semora cast doubt on this story—if not undermine it entirely.⁵

18 Counterclaim Defendants misleadingly state that “neither Wizards nor its counsel had ever
 19 seen a copy of TSR’s actual SFNG Game transcript before documents were produced by third
 20 parties in this case and shared with Counterclaim Defendants’ counsel on September 27, 2022—
 21 after the Motion was filed.” Resp. 9-10. Counterclaim Defendants appear to be distinguishing
 22 between the LaNasa SFNG, which they have filed as an exhibit, and the Subpoenaed SFNG. For
 23 the avoidance of doubt, Wizards’ counsel received and reviewed the Subpoenaed SFNG before
 24

25 ⁵ Other aspects of Counterclaim Defendants’ story likewise fail to line up. LaNasa declares he received from WTG
 26 five copies of SFNG, each “in a color printed three-ring binder.” LaNasa Decl. ¶ 24. He states he “made five exact
 27 photocopies of one of the binders” and “shared three of the three-ring binders... and copies thereof with three close
 personal friends.” *Id.* ¶¶ 24, 27. But the version LaNasa attaches as Exhibit K to his declaration is not in color, and
 it is labeled “BETA COPY 8 OF 10.” *Id.* Ex. K at 2. Neither the grayscale imaging nor the exhibit’s notation as the
 eighth distributed copy is at all consistent with LaNasa’s declared facts.

1 filing the Motion—and indeed, filed excerpts of it with the Court. *See* Rainwater Decl. ¶ 12 &
 2 Ex. E. Wizards’ counsel provided Counterclaim Defendants’ counsel with copies of the
 3 third-party production containing the Subpoenaed SFNG on September 9, 2022, the day after filing
 4 the Motion and two days after receiving the production. *See* Rainwater Suppl. Decl. ¶ 3 and Ex. B.
 5 That Counterclaim Defendants dispute the authenticity of the Subpoenaed SFNG does not indicate
 6 a lack of reasonable inquiry by Wizards’ counsel, as Counterclaim Defendants claim, *see* Resp.
 7 9;⁶ *see also Prissert v. EMCORE Corp.*, 289 F.R.D. 342, 346 (D.N.M. 2012) (counsel’s use of
 8 documents “subject to reasonable dispute” about “authenticity” and “substantive validity” did not
 9 suggest failure to conduct a reasonable inquiry). In any event, as described above, the Subpoenaed
 10 SFNG’s metadata links it to Counterclaim Defendants.

11 *Second*, even if Counterclaim Defendants’ version of the events regarding the Subpoenaed
 12 SFNG were true, their activities caused its dissemination and infringement of Wizards’ Marks.
 13 Counterclaim Defendants admit they have been working on SFNG—drafting SFNG, marketing it
 14 on the Museum and TSR LLC websites, distributing at least some number of copies of at least one
 15 version for playtesting, and promoting it to consumers. Even if Counterclaim Defendants are right
 16 that a third party changed their draft and leaked it to besmirch them—and that is doubtful, as
 17 discussed above—that would not have occurred if Counterclaim Defendants had not been making
 18 SFNG in the first place. Wizards’ reputation also would not have been implicated if Counterclaim
 19 Defendants had opted against using Wizards’ Marks. Wizards would not face reputational harm
 20 by mistaken association (or need the Court’s assistance to avoid it) if, for example, a third party
 21 edited and leaked an RPG called “Galaxy Adventures” initially drafted by the “LaNasa Game Co.”
 22 Wizards faces irreparable harm only because of Counterclaim Defendants’ activities and their
 23 infringement of Wizards’ Marks.

24 *Finally*, setting aside the Subpoenaed SFNG version, Wizards *also* would be harmed by
 25

26 ⁶ Nor did counsel “inaccurately” attest to any personal knowledge with respect to the play test release, as Counterclaim
 27 Defendants insinuate, *see* Resp. 15-16. The Rainwater declaration submitted gaming media articles and stated that
 “the gaming press reported the Star Frontiers New Genesis product included racist and transphobic content,”
 Rainwater Decl. ¶ 10—a wholly accurate description of the press coverage, as the exhibits attached showed.

1 the distribution of the version of SFNG to which LaNasa attested. Counterclaim Defendants argue
 2 that the LaNasa SFNG, which they say is a real draft, “does not contain the offensive content cited
 3 by Wizards,” Resp. 14, but the exhibit contains multiple offensive elements of its own:

- 4 • Under “Star Law,” “mutiny” includes “a rising of slaves on a planet where slavery is
 5 recognized by law or custom” and is punishable by death. LaNasa Decl. Ex. K at 27-28.
- 6 • The game plot history describes that one “race interbred with another compatible race”
 7 “[w]ith the rise of the eugenics movement.” *Id.* at 30.
- 8 • Players “choose a race that [they’d] like to portray in the game world. Keep in mind
 9 all of the races have different abilities and weaknesses.” *Id.* at 39.
- 10 • Among the “humanoid” races is the “Nordic” race, described as “Tall, blonde, blue-
 11 eyed race with exceptional attributes and powers ALL Attributes are in the 13+ range.”
 12 *Id.* at 63. This race and description trades on white supremacist notions of
 13 superiority—i.e., “exceptional attributes and powers.”⁷
- 14 • The explicit “GENDER[s]” for the “humanoid class” are “Male / Female.” *Id.* at 66.
- 15 • The “Looks” characteristic states that “a gorgeous woman who is well endowed with a
 16 near-perfect figure, hair, eyes, etc., will tend to garner attention from most males when
 17 she walks into a room.” *Id.* at 51. A female character “can increase their score
 18 artificially with the use of cosmetics. Put on some eyeliner! Some shadow will do the
 19 trick.” *Id.*

20 These examples demonstrate that the LaNasa SFNG excludes and diminishes many people.
 21 As Wizards explained in its Motion, it is committed to a culture of gaming that embraces diversity
 22 and welcomes everyone. *See* Mot. 5-7. The LaNasa SFNG’s racist and sexist content violates
 23 Wizards’ philosophy. Publication thus risks Wizards’ reputation, should consumers inaccurately
 24 attribute SFNG to it—as they are likely to do because of TSR LLC’s use of Wizards’ Marks.

25

26 ⁷ See also Tom Birkett, *Why Far Right Groups Co-Opt Norse Symbols*, Fast Company (Jan. 13, 2021),
<https://www.fastcompany.com/90593544/why-far-right-groups-co-opt-norse-symbols>; Dorothy Kim, *White
 27 Supremacists Have Weaponized an Imaginary Viking Past. It’s Time to Reclaim the Real History*, Time (Apr. 15, 2019, 9:35 AM), <https://time.com/5569399/viking-history-white-nationalists/>.

1 Counterclaim Defendants do not directly contest the possibility of the reputational damage
 2 to Wizards. Indeed, they concede that the Subpoenaed SFNG contains offensive content (which
 3 they disclaim). *See* Johnson Decl. ¶ 8; LaNasa Decl. ¶¶ 25, 22. But regardless of whether
 4 Counterclaim Defendants created that content—and the currently available document metadata
 5 indicates they did—or if it was added by someone else, that material only became public and posed
 6 a risk to Wizards’ reputation due to Counterclaim Defendants’ use of Wizards’ Marks. And the
 7 LaNasa SFNG—which Counterclaim Defendants authenticate—likewise contains offensive
 8 content that would harm Wizards’ reputation if consumers mistakenly attributed it to Wizards.
 9 Both the Subpoenaed SFNG and the LaNasa SFNG thus show that Wizards will be irreparably
 10 harmed absent an injunction preventing Counterclaim Defendants from infringing its Marks
 11 through the publication and distribution of this product. The disputed history of the Subpoenaed
 12 SFNG document makes no difference in that conclusion.

13 **C. Counterclaim Defendants Assert No Interest in Publishing SFNG; the Balance
 14 of Equities Tips in Wizards’ Favor.**

15 Because Wizards has shown a likelihood of success on the merits on its trademark claims,
 16 the balance of equities weighs in favor of an injunction as a matter of law. *See AECOM Energy*
& Constr., Inc. v. Morrison Knudsen Corp., 748 F. App’x 115, 120 (9th Cir. 2018); *Dr. Seuss*
Enters., L.P. v. Penguin Books USA, Inc., 924 F. Supp. 1559, 1574 (S.D. Cal. 1996), *aff’d*, 109
 19 F.3d 1394 (9th Cir. 1997). Counterclaim Defendants do not dispute this conclusion; they argue
 20 only that Wizards has not met its burden on the likelihood-of-success prong. Resp. 24. But as
 21 discussed above, Wizards established that it is likely to succeed on its claims. Counterclaim
 22 Defendants further concede that an infringing party has no equitable interest in continuing to
 23 infringe another’s marks. They also do not argue that they have any other equitable interest in
 24 continuing to use Wizards’ Marks in connection with SFNG. To the contrary, they argue that
 25 SFNG “has never been available for sale to consumers in the marketplace, and the Counterclaim
 26 Defendants have not sold (or attempted to sell) a single copy of the SFNG Game to anyone.” Resp.
 27 18. Enjoining Counterclaim Defendants to preserve this status quo will not harm them in any way.

1 The equities here are one-sided in favor of Wizards.

2 **D. The Public Interest Supports a Preliminary Injunction.**

3 As to the public interest, Counterclaim Defendants again merely reiterate their assertion
 4 that Wizards has not met its burden. Resp. at 24. For all the reasons previously discussed,
 5 Counterclaim Defendants are wrong. An injunction here will serve the public interest by enforcing
 6 Wizards' trademark rights and protecting the public from confusion. *See State of Idaho Potato*
 7 *Comm'n v. G & T Terminal Packaging, Inc.*, 425 F.3d 708, 715 (9th Cir. 2005); *CytoSport, Inc. v.*
 8 *Vital Pharms., Inc.*, 617 F. Supp. 2d 1051, 1081 (E.D. Cal. 2009), *aff'd*, 348 F. App'x 288 (9th
 9 Cir. 2009). Counterclaim Defendants offer no argument otherwise as to this factor.

10 **CONCLUSION**

11 Counterclaim Defendants' disputes about the authenticity and origin of the Subpoenaed
 12 SFNG game do not undermine Wizards' entitlement to an injunction preventing Counterclaim
 13 Defendants from publishing, distributing, or otherwise making available any iteration of SFNG.
 14 Wizards has shown that it is likely to succeed on the merits on its claims because it has superior
 15 rights to the Marks Counterclaim Defendants plan to or already use in commerce, and that use is
 16 likely to confuse consumers under the *Sleekcraft* test. Wizards is irreparably harmed by
 17 Counterclaim Defendants' activities around SFNG because (a) the Subpoenaed SFNG appears to
 18 have originated with LaNasa's co-author; (b) the Subpoenaed SFNG exists only because of
 19 Counterclaim Defendants, even if they did not create it; and (c) even the LaNasa SFNG, which
 20 Counterclaim Defendants authenticate, contains offensive material contrary to Wizards'
 21 commitment to inclusive gaming. Counterclaim Defendants do not raise any discrete arguments
 22 pertaining to the equitable and public interest factors, which also favor an injunction.

23 The Court should grant Wizards' Motion and enjoin Counterclaim Defendants from any
 24 further public activity with respect to any iteration of Star Frontiers New Genesis.

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